APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/520,810	03/08/2000	Noriyuki Fukuyama	F0540FT	2159

21171	7590	06/25/2004

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EXAMINER
LY, ANH VU H

ART UNIT	PAPER NUMBER
2667	

DATE MAILED: 06/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/520,810	FUKUYAMA ET AL.
	Examiner	**Art Unit**	
	Anh-Vu H Ly	2667	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>04 May 2004</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-37* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *11,18-24,26 and 27* is/are allowed.

6)☒ Claim(s) *1-6,15,16 and 28-37* is/are rejected.

7)☒ Claim(s) *7-10,12-14,17 and 25* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All   b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set forth in

37 CFR 1.17(e), was filed in this application after final rejection. Since this application is

eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)

has been timely paid, the finality of the previous Office action has been withdrawn pursuant to

37 CFR 1.114. Applicant's submission filed on April 12, 2004 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

2.   Claims 1-5 and 34-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Shima (US Pub No. 2002/0004802).

With respect to claim 1, Shima discloses in Fig. 1, a functional configuration for

implementing requested instructions from the information terminal 11 (information terminal) by

the image information input-output unit 1 (a terminal) through a data network (communication

on a packet switched network).

Such data network can be further illustrated in Figs. 3, 9, and 20, network 100 for

connecting the information terminal and the image information input-output unit such as a

scanner, a printer or a web server via I/F interfaces (first and second packet-switched

input/output interfaces).

Shima discloses (page 2, 11th and 12th paragraph and Fig. 1) when retrieval information is entered from the outside of the image information input-output unit 1 (sending from the information terminal to the terminal a phone function control command), the conversion means 5 look up in the management table 5 and converts the retrieval information into predetermined control information. For example, when a URL of http://xxx/action/300 dpi/ is entered, if "action/300 dpi/" is previously related to the control information meaning "read image at read resolution 300 dpi" in the management table 4, the URL is converted into control information by the conversion means 5, whereby the image read operation at 300 dpi is executed (controlling from the terminal at least one of a phone function according to the phone function control command from the packet switched phone controller).

Shima does not disclose that the terminal is a phone terminal and the information terminal is a phone controller. However, voice communications over the packet switched network, e.g., VoIP has been long known in the art. Therefore, it would have been obvious to one having ordinary skilled in the art at the time the invention was made to replace a scanner, a printer, or w web server with a phone device in Shima's system, and carry out the same method as taught by Shima, for controlling devices located separated over a packet switched network.

With respect to claims 2-4 and 34-37, Shima discloses in Fig. 1, a functional configuration for implementing requested instructions from the information terminal 11 (information terminal) by the image information input-output unit 1 (a terminal). Shima discloses (col. 1, 6th paragraph) image information input-output units have been often shared

through various networks such as a LAN and an intranet (communication on a packet switched

network via input/output interfaces).

Shima discloses in Fig. 1, the information terminal 11 (information terminal) comprising

a read retrieval means 12 (a terminal controller) for generating retrieval information. Further

Shima discloses (page 2, 12th paragraph) wherein retrieval information is used to indirectly

specify control information, whereby predetermined image information input-output processing

is performed. Thus if the user uses an information terminal that can issue retrieval information

for using the hypertext information retrieval environment 2 resided within the image information

input-output unit 1 (information terminal includes a terminal controller that generates a control

command based on an instruction from a user, the control command including an instruction

related to a packet-switched network multimedia phone call function on packet-swtiched

network and/or related to a phone function control of the packet-switched phone and the packet-

switched phone controller sends the instruction to the packet-switched phone).

Shima discloses in Fig. 1, the image information input-output unit 1 (terminal)

comprising an information retrieval environment 2 for implementing the retrieval information

sent by the information terminal 11 (a phone controller controls at least one of the packet-

switched network multimedia phone call function with another packet-switched phone on the

packet-switched network and/or the phone function, according to the call function control

command and/or the phone function control command from the packet-switched phone

controller).

Shima does not disclose that the terminal is a phone terminal and the information

terminal is a phone controller. However, voice communications over the packet switched

network, e.g., VoIP has been long known in the art. Therefore, it would have been obvious to

one having ordinary skilled in the art at the time the invention was made to replace a scanner, a

printer, or w web server with a phone device in Shima's system, and carry out the same method

as taught by Shima, for controlling devices located separated over a packet switched network.

With respect to claim 5, Shima discloses in Fig. 20, image information processing system

comprising the information terminal 61 (information terminal), a management server 121, a

plurality of scanners and printers (a plurality of terminals). Shima discloses (page 13, 219th –

224th paragraphs) an operation executed among the information terminal 61 (information

terminal), the management server 121 (one of the terminals), and the scanner 121 (another

terminal). When the information terminal 61 requests the web server section 123 of the

management server 121 to transfer a general page WP21 (sending from information terminal to a

one of terminals an instruction related to a packet-switched network multimedia phone call

function on the packet-switched network and/or related to a phone function control of one

packet-switched phone). If the user chooses a desired parameter out of a read resolution choice

page, a URL indicating the parameter is sent to the management server 121. The URL

interpretation section 126 of the management server 121 converts the received URL into a

predetermined control command. The control command is transmitted to a predetermined

scanner 131, when then interprets the control command, executes scan processing, and transfers

an image file provided by scanning to the management server 121, which then transfers the

image file received from the scanner 131 to the information terminal 61 (performing in one

terminal at least one of the packet-switched network multimedia phone call function with another

packet-switched phone on packet switched network and/or the phone function, according to instruction from phone controller).

Shima does not disclose that the terminal is a phone terminal and the information terminal is a phone controller. However, voice communications over the packet switched network, e.g., VoIP has been long known in the art. Therefore, it would have been obvious to one having ordinary skilled in the art at the time the invention was made to replace a scanner, a printer, or w web server with a phone device in Shima's system, and carry out the same method as taught by Shima, for controlling devices located separated over a packet switched network.

3.   Claims 6, 15-16, 28-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shima (US Pub No. 2002/0004802) in view of Szlam (US Patent No. 6,359,892).

With respect to claims 6, 15, 16, 28-33, Shima discloses in Fig. 20, image information processing system comprising the information terminal 61 (information terminal), a management server 121, a plurality of scanners and printers (a plurality of terminals) on network 100 (communication on a packet switched network via input/output interfaces).

Shima discloses (page 13, 219th – 224th paragraphs) when the information terminal 61 requests the web server section 123 of the management server 121 to transfer a general page WP21, the management server 121 returns the general page WP21 to the information terminal 61. The general page WP21 is a page indicating the business machines connected to the network 100 for each type, such as scanners and printers, as shown in Fig. 22. Shima does not explicitly disclose the information terminal includes a control target list. Szlam discloses (col. 20, lines 9-11) a method of storing the user information of the remote communication device 10 in the

controller 225. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include the general page WP21 in the information terminal in Shima's system, as suggested by Szlam, in order to identify the connected machines in the network 100.

Shima discloses in Fig. 1, the information terminal 11 (information terminal) comprising a read retrieval means 12 (a first control means) for generating retrieval information. Further Shima discloses (page 2, 12th paragraph) wherein retrieval information is used to indirectly specify control information, whereby predetermined image information input-output processing is performed. Thus if the user uses an information terminal that can issue retrieval information for using the hypertext information retrieval environment 2 resided within the image information input-output unit 1 (terminal controller generating, based on an instruction from a user, a control command that includes an instruction related to control of the terminal, and information terminal being configured to send the control command to one of the terminals).

Shima does not disclose communication terminal includes a terminal list including information relating to the information terminal. Szlam discloses (col. 20, lines 9-11) the user of the remote communication device 10 (information terminal) can store a user profile in the controller 225 (a communication terminal) which the controller 225 inspects whenever an incoming call for the user is received. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a method of storing user profile of the remote communication device (terminal list including information relating to the information terminal) in the controller 225 (communication terminal) in Shima's system, as suggested by Szlam, in order to authenticate and verifying the originated control commands.

Shima discloses (page 13, 219th – 224th paragraphs) that if the user chooses a desired

parameter out of a read resolution choice page, a URL indicating the parameter is sent to the

management server 121. The URL interpretation section 126 of the management server 121

converts the received URL into a predetermined control command. The control command is

transmitted to a predetermined scanner 131, when then interprets the control command, executes

scan processing, and transfers an image file provided by scanning to the management server 121,

which then transfers the image file received from the scanner 131 to the information terminal 61

(a phone controller performing, based on the multimedia phone communication control

command received from the information terminal, the multimedia communication with another

terminal on the packet switched network).

Shima does not disclose that the terminal is a phone terminal and the information

terminal is a phone controller. However, voice communications over the packet switched

network, e.g., VoIP has been long known in the art. Therefore, it would have been obvious to

one having ordinary skilled in the art at the time the invention was made to replace a scanner, a

printer, or w web server with a phone device in Shima's system, and carry out the same method

as taught by Shima, for controlling devices located separated over a packet switched network.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United
States before the invention thereof by the applicant for patent, or on an international application by another who
has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention
thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999

(AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002

do not apply when the reference is a U.S. patent resulting directly or indirectly from an

international application filed before November 29, 2000. Therefore, the prior art date of the

reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA

35 U.S.C. 102(e)).

4.   Claims 5, 29, 31, and 33 are rejected under 35 U.S.C. 102(e) as being anticipated by

Szlam (US Patent No. 6,359,892).

With respect to claim 5, Szlam discloses in Fig. 1, the portable communication device 10

(information terminal) connects to the outside party 12, main office 13, branch office 14, and

other office 15 via a the communication links 11. Further, as illustrated in Fig. 2B, a plurality of

office equipments, resided within the main office 13, are, but not limited to, telephone sets

217A-C, computers 221A-C, corporate devices, equipment, resources and services 220, etc... (a

plurality of communication terminals). Szlam discloses (col. 8, lines 32-40) the communication

links may be the cellular telephone service, satellite link services, private carriers, the Internet

via an ISP (packet switched network), two-way cable service, ATM lines, etc....

Szlam discloses (col. 9, lines 47-51) that the controller 225, as illustrated in Fig. 2B, can

receive commands from the remote communication device 10 (sending from the information

terminal to a first of communication terminals an instruction related to packet-switched network

phone call function and/or phone function on the packet switched network), converts these

commands to CTI commands, and send the CTI commands to the appropriate device, such as the

PBX 216 (performing in one packet switched phone at least one of call function with another

packet switched phone and/or the phone function according to instruction from packet-switched

phone controller).

With respect to claims 29, 31, and 33, Szlam discloses (col. 20, lines 9-11) the user of the

remote communication device 10 (information terminal) can store a user profile in the controller

225 (a communication terminal) which the controller 225 inspects whenever an incoming call for

the user is received (a terminal list wherein is stored information relating to a predetermined

information terminal also connected to the packet switched network). Szlam discloses (col. 9,

lines 47-51) that the controller 225, as illustrated in Fig. 2B, can receive commands from the

remote communication device 10, converts these commands to CTI commands, and send the CTI

commands to the appropriate device, such as the PBX 216 (a second control means that receives

from predetermined information terminal a control command wherein is recorded an instruction

related to media communication, and performs, based on the control command, media

communication with another communication on the packet switched network).

Allowable Subject Matter

5.   Claims 7-10, 12-14, 17, 25 are objected to as being dependent upon a rejected base claim,

but would be allowable if rewritten in independent form including all of the limitations of the

base claim and any intervening claims.

6.   Claims 11, 18-24, 26 and 27 are allowed.

The following is an examiner's statement of reasons for allowance:

The prior art does not teach or fairly suggest a terminal controller transmitting, based on

an instruction from a terminal user, a multimedia phone communication control command and a

control command that instructs a predetermined multimedia phone communication processing according to a state of the multimedia phone communication and the detected state of the packet-switched phone user and a phone controller performing, based on the multimedia phone communication control command from the information terminal, the multimedia phone communication with another packet-switched phone on the packet switched network, and transmitting a control command that reports the state of the multimedia phone communication with the other packet-switched phone to the information terminal, as specified in independent claim 11.

The prior art does not teach or fairly suggest a terminal controller transmitting, based on an instruction from a terminal user, a multimedia phone communication control command and a control command that instructs a predetermined multimedia phone communication processing according to a state of the multimedia phone communication and a phone controller transmitting a control command, that reports the state of the multimedia phone communication, to the information terminal and performing the multimedia phone communication with another packet-switched phone on the packet switched network according to the multimedia phone communication control command having a highest priority from among a plurality of multimedia phone communication control commands transmitted from the information terminal in response to the multimedia phone communication state control command reporting of the multimedia phone communication state by the phone controller, as specified in independent claim 18.

The prior art does not teach or fairly suggest a terminal controller transmitting, based on an instruction from a terminal user, a multimedia phone communication control command and a recorded message information retrieval control command, to one of the packet-switched phone; a

phone controller performing, based on the multimedia phone communication control command

received from the information terminal, the multimedia phone communication with another

packet-switched phone on the packet switched network, and transmitting, based on the recorded

message information retrieval control command, a control command including the recorded

message information stored in the data storage of the packet-switched phone to the information

terminal, as specified in independent claims 19-21.

The prior art does not teach or fairly suggest a terminal controller transmitting, based on

an instruction from a terminal user, a multimedia phone communication control command and a

communication log retrieval control command, to one of the packet-switched phone; a phone

controller performing, based on the multimedia phone communication control command

received from the information terminal, the multimedia phone communication with another

packet-switched phone on the packet switched network, and transmitting, based on the

communication log retrieval control command, the retrieved communication log control

command that includes the communication log stored in the data storage of the packet switched

phone to the information terminal, as specified in independent claim 22.

The prior art does not teach or fairly suggest a terminal controller transmitting, based on

an instruction from a terminal user, a multimedia phone communication control command and a

message storage control command, to one of the packet-switched phone; a phone controller

performing, based on the multimedia phone communication control command received from the

information terminal, the multimedia phone communication with another packet-switched phone

on the packet switched network, and storing, based on the message storage control command, the

message in the data storage, and reporting storage of the stored message to the other packet-switched phone, as specified in independent claim 23.

The prior art does not teach or fairly suggest a terminal controller transmitting, based on an instruction from a terminal user, a multimedia phone communication control command and a forward destination setting control command, to one of the packet-switched phone; a phone controller performing, based on the multimedia phone communication control command received from the information terminal, the multimedia phone communication with another packet-switched phone on the packet switched network, storing, based on forward destination setting control command, the forwarding destination setting in the data storage of the packet switched phone, and reporting storage the forwarding destination setting to the other packet-switched phone in a predetermined case, as specified in independent claim 24.

The prior art does not teach or fairly suggest the information terminal comprising a processing table that associates an input unit of a packet switched phone with a predetermined processing; a terminal controller transmitting, based on an instruction from a terminal user, a multimedia phone communication control command, and referencing the processing table based on an input occurrence report control command, and performing a processing corresponding to the input unit with the input occurrence; a phone controller performing, based on the multimedia phone communication control command received from the information terminal, the multimedia phone communication with another packet-switched phone on the packet switched network, and transmitting the input occurrence report control command, based upon an input to the input unit, to the information terminal, as specified in independent claim 26.

The prior art does not teach or fairly suggest a terminal controller transmitting, based on an instruction from a terminal user, a multimedia phone communication control command and authentication information; a phone controller performing, based on the multimedia phone communication control command received from the information terminal, the multimedia phone communication with another packet-switched phone on the packet switched network; and comparing authentication information included in the multimedia phone communication control command and the authentication information of the terminal list to authenticate the information terminal, as specified in independent claim 27.

Response to Arguments

7.   Applicant's arguments filed May 04, 2004 have been fully considered but they are not persuasive.

Applicant argues on pages 25-26 that Shima fails to teach or suggest a packet-switched phone controller controlling a packet-switched network phone call between one packet-switched phone and another packet-switched phone.

Examiner respectfully disagrees, as recited in lines 14-18 of independent claim 1, "controlling from the packet-switched phone at least one of the packet-switched phone call function with another packet-switched phone on the packet-switched network **and/or the phone function**" is interpreted as "controlling from the packet-switched phone at least one of the phone function" by the examiner. Herein, applicant should understand that **"or the phone function"** is not absolutely meant a phone call function. A phone function can be interpreted as any function implemented by the phone by the examiner. Therefore, applicant's arguments are not directed to the claimed invention.
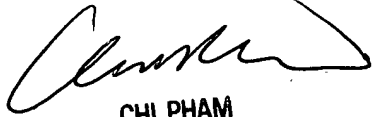
Conclusion

8.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Anh-Vu H Ly whose telephone number is 703-306-5675. The

examiner can normally be reached on Monday-Friday 7:00am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Chi Pham can be reached on 703-305-4378. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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